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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,426	10/01/2003	Robert O. Messing	316E-000112US	8451
22798	7590	11/19/2004	EXAMINER	
QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C. P O BOX 458 ALAMEDA, CA 94501			RUSSEL, JEFFREY E	
			ART UNIT	PAPER NUMBER

1654

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/677,426

Applicant(s)

MESSING ET AL.

Examiner

Jeffrey E. Russel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20031001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The preliminary amendment to the specification filed October 1, 2003 has not been entered because it was not submitted in appropriate form under 37 CFR 1.121(b)(1)(ii). The changes to the paragraph being replaced were not marked with strikethrough and underlining as required by the rule. Also, the status of the parent non-provisional applications should be updated. Correction is required.

2. The disclosure is objected to because of the following informalities: The status of the U.S. patent application at page 9, line 21, of the specification should be updated. Appropriate correction is required.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,376,467. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '467 patent anticipate instant claim 1.

5. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,686,334. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '334 patent anticipate instant claim 1.

6. Instant claim 1 is deemed to be entitled under 35 U.S.C. 119(e) to the benefit of the filing date of provisional application 60/103,763 because the '763 application, under the test of 35 U.S.C. 112, first paragraph, discloses the claimed invention.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the Ahlgren et al article (J. Neurophysiology, Vol. 72, pages 684-692) in view of the Schaap et al article (J. Biological Chemistry, Vol. 265, pages 7301-7307). The Ahlgren et al article teaches decreasing hyperalgesia in streptozotocin-diabetic rats by administering staurosporine. For determining the behavioral mechanical nociceptive thresholds, administration is local by intradermal injection. Suprathreshold testing corresponds to Applicants' chronic pain. The STZ-D rats are used to model diabetic neuropathy. Staurosporine did not alter the nociceptive threshold in control rats, and therefore would not have been expected to affect nociception, i.e. the basal response, in the STZ-D rats. See, e.g., the Abstract; page 685, column 1; and Figure 2. The Schaap et al article

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(see, e.g., the Abstract) teaches that staurosporine is an inhibitor of PKC ϵ , although it is not a selective inhibitor of PKC ϵ .

9. Claim 1 is rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Demopulos et al in view of the Gekeler et al article (Br. J. Cancer, Vol. 74, pages 897-905). Demopulos et al teach a method for perioperatively inhibiting pain and inflammation resulting from vascular therapeutic and diagnostic procedures by locally administering a solution comprising a plurality of agents including a cyclooxygenase inhibitor (which is a non-steroidal anti-inflammatory drug) and a PKC inhibitor. A preferred and exemplified PKC inhibitor is GF 109203X.

Administration can be by irrigation, which constitutes topical administration of the active agents.

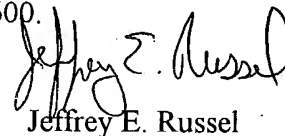
See, e.g., the Abstract; column 37, lines 8-35; column 43, Example VII; and claims 3 and 12.

The Gekeler et al article teaches that GF 109203X inhibits PKC ϵ (see, e.g., the Abstract), although it is not a selective inhibitor of PKC.

10. The examiner maintains his position for the reasons set forth during prosecution of the parent applications.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (571) 272-0969. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Bruce Campell can be reached at (571) 272-0974. The fax number for formal communications to be entered into the record is (703) 872-9306; for informal communications such as proposed amendments, the fax number (571) 273-0969 can be used. The telephone number for the Technology Center 1600 receptionist is (571) 272-1600.



Jeffrey E. Russel
Primary Patent Examiner
Art Unit 1654

JRussel
November 17, 2004